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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/258,609 | 02/26/1999 | HIROSHI KOBATA | EPC-009 | 4096 |
| 26171 | 7590 | 01/27/2006 | EXAMINER | |
| FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | KANG, PAUL H | |
| | | | ART UNIT | PAPER NUMBER |

2141

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/258,609

Applicant(s)

KOBATA ET AL.

Examiner

Paul H. Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-32 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., US Pat. No. 5,790,790 in view of Ishibashi et al., EP 0 812 100 A2.

3. As to claims 34, 13 and 16, Smith discloses an apparatus for delivering a document to a receiving station over a network, comprising (See Smith, col. 2, lines 20-31):

a server system connected to the network and storing digital information received over the network (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10); and

the apparatus connected to the network and transmitting a notification to the receiving system, the notification signifying that the sending system is transmitting the digital information over the network to the server system and that the digital information may be accessible by the receiving system at the server system (Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

However, Smith does not explicitly teach that the sending system transmits both the digital information and a notification to the receiving system. In the same field of endeavor,

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Ishibashi teaches a system for transmitting from a sending machine a notification to the recipient as well as the digital information to a storage server (See Ishibashi, Abstract and page 2, lines 40-59 and page 6, lines 6-27 and page 6, line 27 – page 7, line 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the method of transmitting both a notification and digital information as taught by Ishibashi into the system of Smith for the purpose of providing an efficient and immediate notification and message transmission system.

4. As to claims 2 and 23, Smith-Ishibashi teach the server system receives the digital information from the sending system (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

5. As to claims 5-7, Smith-Ishibashi teach a storage device in communication with the server and wherein the server system stores the digital information at an address location of the storage device, and wherein the server system includes a page providing a path by which the receiving system can access the digital information at the address location, wherein the notification has a resource locator which addresses the page on the server system (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

6. As to claims 8 and 27, Smith-Ishibashi teach the page requests valid authentication information from the receiving system before granting access to the digital information (Smith,

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lines 17-49).

7. As to claims 9-11, Smith-Ishibashi teach a page which provides access to a graphical window describing contents of the digital information and resource locators reference multiple locations in the storage device to access the data structure using the unique identifiers (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

8. As to claims 17 and 19, Smith-Ishibashi teach transmitting the digital information from the server system to the receiving system in response to a request from the receiving system and executing a server-side software through which the receiving system can obtain access to the digital information (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

9. As to claim 3-4 , 12, 14-15 and 24-26, Smith-Ishibashi teach a second server system in communication with the sending system and the first server system, wherein the first server system receives the digital information from the sending system via the second server system, acting logically as a single server system (See Smith, col. 3, line 47-62).

10. As to claims 18 and 28-29, Smith-Ishibashi teach the invention substantially as claimed. However, Smith-Ishibashi do not explicitly teach the step of tracking the digital information in real-time, confirming that the receiving system has completely received the digital information and notifying the sending system when the receiving system starts using the digital information.

Official notice is taken (see MPEP 2144.03) that tracking message transmission was well known in the computer networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a method of confirming that a message was completely received into the system of Smith-Ishibashi for the purpose of increasing data transmission reliability.

11. As to claims 20 and 21, Smith-Ishibashi teach the step of maintaining a page on the server system through which the receiving system can obtain access to the digital information and the notification includes the resource locator for accessing the page (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

12. As to claim 22, Smith-Ishibashi teaches the step of concurrently sending a notification and digital information (notification to the recipient from the sender that a message is being transmitted to a server is sent “almost simultaneous” with the transmission of the message. Ishibashi, page 2, lines 42-59).

13. As to claims 30 and 31, Smith-Ishibashi teaches the invention substantially as claimed. However Smith-Ishibashi does not explicitly teach the step of canceling delivery after sending the digital information.

Official notice is taken (see MPEP 2144.03) that canceling a message was as well known in the computer networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a step to cancel a message

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anytime after it has been sent into the system of Smith-Ishibashi for the purpose of enhancing the control of the data transmission.

14. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith-Ishibashi, as applied above, further in view of Romrell, US Pat. No. 6,396,805 B2.

15. As to claim 32, Smith-Ishibashi teaches the invention substantially as claimed. However Smith-Ishibashi does not explicitly teach the step of restarting a connection after an interruption at the point of interruption.

In the same field of endeavor, Romrell teaches a system and method for recovering from interruptions of data transfer retransmission after interruption starts at the point of interruption (see Romrell, claim 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated method to restart a connection at the point of interruption, as taught by Romrell, into the system of Smith-Ishibashi for the purpose of increasing system fault tolerance.

Response to Arguments

Applicant's arguments filed August 23, 2005 have been fully considered but are not deemed to be persuasive. The applicants argued in substance that the prior art of record merely teaches transmitting a notification "almost simultaneous" to the transmission of digital information to the server. Applicants allege this is patentably distinct with "sending... the notification signifying that the sending system is transmitting the digital information."

The examiner respectfully disagrees. The applicants are reminded that during examination, the claims are given the broadest reasonable interpretation consistent with the specification and the prior art. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The rationale for such interpretation is to reduce the possibility that the claims, once issued, are interpreted more broadly than justified, since applicant always has the opportunity to amend the claims during prosecution. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. §101 and §102. In the 35 U.S.C. §102 rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

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Here, when given the broadest reasonable interpretation consistent with the specification the invention as claimed require no more than “a sending system...transmitting a notification.” The timing of the transmission of the notification relative the transmission of the message itself is not clearly defined by the claim language. The language “the notification signifying that the sending system is transmitting the digital information” requires merely that a user is notified of a message sent placed on the server by the sender. Were timing critical to the function of the system, delays associated with transmission, as well as application processes responsible for transmitting the notification and digital information, must be clearly recited in the claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

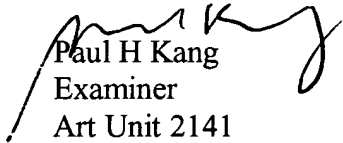
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul H Kang
Examiner
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